

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANTS' REPLY BRIEF

APPELLANTS:	Turner et al.	CONFIRMATION NO. 3107
SERIAL NO.:	10/007,899	GROUP ART UNIT: 2116
FILED:	November 5, 2001	EXAMINER: Tse W. Chen
TITLE:	"ARRANGEMENT FOR THE POWER SUPPLY FOR A SECURITY DOMAIN OF A DEVICE"	

MAIL STOP APPEAL BRIEF- PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

S I R:

In accordance with the provisions of 37 C.F.R. §41.41, Appellants herewith submit their Reply Brief in response to the Examiner's Answer dated July 18, 2007.

Appellants believe the statements made by the Examiner in the Examiner's Answer filed July 18, 2007 regarding the individual issues on appeal are adequately addressed in Appellants' Main Brief. The present Reply Brief is being filed to permit Appellants to comment on the decision of the United States Supreme Court in *KSR International Co. v. Teleflex Inc.*, ___ U.S. ___, 127 S.Ct. 1727, 82 USPQ 2nd 1385 (2007) that was decided since the time Appellants' Main Brief was filed. The *KSR* decision has received a considerable amount of inaccurate publicity to the effect that the decision allegedly does away with the requirement to find a "teaching, suggestion or motivation" explicitly in the prior art of record in order to substantiate a rejection or an invalidity argument based on 35 U.S.C. §103(a). Appellants submit the *KSR* decision does not stand for such a proposition, and in fact endorses and approves of the requirement for vigorously substantiating an obviousness argument with detailed

evidence. The *KSR* decision, however, recognized that the level of detail must not be rigidly and inflexibly set, and the Supreme Court recognized that there will undoubtedly be situations wherein the distinction between the claimed subject matter and the prior art is so minimal that a relaxed evidentiary argument will suffice. Even after the *KSR* decision, however, it is clear that an obviousness rejection can never be based on speculation, nor can it be based on a substitution of the Examiner's opinion in opposition to clear statements in the prior art that tend to support a non-obviousness conclusion, rather than an obviousness conclusion.

In order to dispel the notion that the *KSR* decision somehow gives license to an obviousness rejection that fails to identify a teaching, motivation or suggestion in the prior art, it is worth quoting several passages from the *KSR* decision at length.

At 127 S.Ct. 1740, after discussing the earlier Supreme Court decisions in *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) and *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273 (1976), the Supreme Court in the *KSR* decision stated:

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson's-Black Rock* are illustrative - a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

The Supreme Court then made the following extremely important statement, which is highly relevant to assessing the obviousness of the subject matter in the present appeal:

Following these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another, or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take into account the influences and creative steps that a person of ordinary skill in the art would employ.

As to the reliance on the requirement for demonstrating a teaching, suggestion or motivation in the prior art of record, the Supreme Court stated at 127 S.Ct. 1741

When it first established the requirement of demonstrating a teaching, suggestion or motivation to combine known elements in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight.

The Supreme Court then stated at 127 S.Ct. 1741 that the Court of Customs and Patent Appeals and the United States Court of Appeals for the Federal Circuit have *no doubt* applied the requirement for a teaching, motivation or suggestion to be identified in the prior art in accord with the principles discussed in the *KSR* decision. The Supreme Court stated there is “no necessary inconsistency” between the idea

underlying the requirement for a teaching, motivation or suggestion, and the analysis required by *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The Supreme Court, as noted above, cautioned only against transforming this general principle into “a rigid rule that limits the obviousness inquiry.”

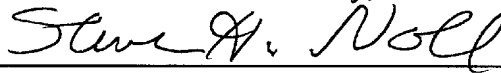
Appellants respectfully submit that the Examiner has not satisfied the rigorous evidentiary standards relating to identification of a teaching or guidance in the prior art with respect to the subject matter of claim 1 of the present application, and Appellants further submit that the only location where such guidance is present is Appellants’ disclosure, on which Appellants respectfully submit the Examiner has impermissibly relied. Nothing in the *KSR* decision alleviates this error of law.

For the reasons discussed above as well as the reasons set forth in Appellants’ Main Brief, Appellants respectfully request reversal of the rejections on Appeal.

An oral hearing is not being request, and therefore the present Appeal is in condition for transmittal to the Board of Patent Appeals and Interferences.

The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519.

Submitted by,



(Reg. 28,982)

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